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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,365	11/12/2003	Johannes Becker	BECKER 1	6816
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EXAMINER				
DEBNATH, SUMAN				
ART UNIT		PAPER NUMBER		
2435				
NOTIFICATION DATE		DELIVERY MODE		
02/10/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@hittgaines.com

### Office Action Summary

**Application No.**

10/706,365

**Applicant(s)**

BECKER, JOHANNES

**Examiner**

SUMAN DEBNATH

**Art Unit**

2435

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-11, 13-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-4, 6-11, 13-18 and 20 are pending in this application.
2. Claims 1, 8 and 15 are currently amended.
3. Claims 5, 12 and 19 were previously cancelled.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

***Continued Examination Under 37 CFR 1.114***

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 08, 2008 has been entered.

***Claim Rejections - 35 USC § 103***

6. Claims 1-4, 8-11 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack et al. (Patent No.: US 5,689,516) (hereinafter, "Mack") and further in view of Kalkunte et al. (Patent No.: US 5,515,523) (hereinafter, "Kalkunte") and Bos et al. (Patent No.: US 7,124,340 B1) (hereinafter, "Bos").

7. As to claim 1, Mack teaches for use with an integrated circuit (IC) having a testing port, a system for securing said IC as against subsequent reprogramming, comprising: port inhibit circuitry located on said IC and modifiable to achieve a configuration that determines an extent to which said testing port is enabled (abstract, FIG. 1, col. 3, lines 25-40), said extent selected from the group consisting of: fully enabled, and completely disabled; and port access circuitry, coupled to said testing port, that enables said testing port based on said configuration (FIG.1, col. 3, lines 25-40, col. 6, lines 5-18 and lines 55-65, col. 7, lines 10-25).

Mack is silent on said extent selected from the group consisting of: only partially disabled, said partially disabled extent allowing a direct loopback between input and output pins of said testing port. However, Kalkunte teaches said extent selected from the group consisting of: only partially disabled (abstract, FIG. 2, col. 6, lines 4-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Mach as taught by Kalkunte in order to "maximize efficient use of the memory component and minimized starvation of other memory ports, without requiring higher performance memory components or wider memory bus widths (Kalkunte, col. 2, lines 55-60)."

Neither Mack nor Kalkunte explicitly disclose wherein said testing port comprises a direct loopback between input and output pins thereof. However, Bos discloses wherein the testing port comprises a direct loopback between input and output pins thereof (column 7, lines 60-67 and column 8, lines 1-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Mack nor Kalkunte as taught by Bos in order to isolate defects within the circuit by supporting loopback testing.

8. As to claims 8 and 15, these are rejected using the same rationale as for the rejection of claim 1.
9. As to claim 2, Mark teaches wherein said testing port is a Joint Test Action Group (JTAG) port (col. 3, lines 25-40).
10. As to claims 9 and 16, these are rejected using the same rationale as for the rejection of claim 2.
11. As to claim 3, Mark teaches wherein said port inhibit circuitry comprises an inhibit bit in a one-time programmable register (col. 6, lines 5-18).
12. As to claims 10 and 17, these are rejected using the same rationale as for the rejection of claim 3.
13. As to claim 4, Mark teaches wherein said port inhibit circuitry is configured to be permanently modified prior to delivering said IC to a user thereof (col. 6, lines 13-18, col. 7, lines 10-25).

14. As to claim 6, neither Mack nor Kalkunte explicitly disclose wherein said testing port comprises a direct loopback between input and output pins thereof. However, Bos discloses wherein the testing port comprises a direct loopback between input and output pins thereof (column 7, lines 60-67 and column 8, lines 1-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Mack nor Kalkunte as taught by Bos in order to isolate defects within the circuit by supporting loopback testing.

15. As to claim 13, it is rejected using the same rationale as for the rejection of claim 6.

16. As to claims 11 and 18, these are rejected using the same rationale as for the rejection of claim 4.

17. Claims 7, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack and further in view of Kalkunte, Bos and Hansford (Patent No.: US 6,522,100 B2).

18. As to claim 7, neither Mack nor Kalkunte and Bos explicitly disclose wherein said IC is a baseband chip of a mobile communication device. However, Hansford discloses wherein the IC is a baseband chip of a mobile communication device (column 1, lines 45-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Mack, Kalkunte and Bos as taught by Hansford in order to receive a frequency signal or frequency information.

19. As to claims 14 and 20, these are rejected using the same rationale as for the rejection of claim 7.

20. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### ***Response to Arguments***

21. Applicant has amended claims 1, 8 and 15, which necessitated new ground of rejection. Please see rejection above. Applicant's arguments filed October 08, 2008 have been considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "partially disabled extent allowing a direct loopback between input and output pins") were not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore Bos discloses wherein the testing port comprises a direct loopback between input and output pins thereof (column 7, lines 60-67 and column 8, lines 1-10).

In response to applicant's argument that "the cited combination of the cited portions of Mack and Kalkunte, as applied by the Examiner and in view of the amendment, does not establish a prima facie case of obviousness of presently amended independent claims 1, 8 and 15", the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, In this case, motivation for the rejections is found both in the knowledge generally available to one of ordinary skill in the art and in the cited references.



***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUMAN DEBNATH whose telephone number is (571)270-1256. The examiner can normally be reached on 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D./  
Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435